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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,377	05/02/2001	Dennis Mendiola	YSAP.CHIKKA.PT2	3927
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INTELLECTUAL PROPERTY LAW GROUP LLP 12 SOUTH FIRST STREET SUITE 1205 SAN JOSE, CA 95113			EWART, JAMES D	
			ART UNIT	PAPER NUMBER
			2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/846,377	Applicant(s) MENDIOLA ET AL.	
	Examiner James D. Ewart	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment dated 14 June, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed June 14, 2006 have been fully considered by the Examiner, but are not persuasive. Applicant argues that "determining whether the initial receiving was associated with a request to register the prospective user from someone other than the prospective user" is not taught by Ilsen et al. Ilsen et al teaches using well-known security procedures of *validating or authenticating an identity* by an information system in Column 30, Lines 9-15. If the identifying information doesn't match up, the ePPi doesn't recognize the user and assumes it's not a prospective user and doesn't let the person on the system. Thus meeting the limitation of "determining the initial receiving was associated with a request to register the prospective user from someone other than the prospective user". If the identifying information matches, then in response to determining the authentication is valid, the user is tentatively registered.

Arrangement of the Specification

2. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) ***CROSS-REFERENCE TO RELATED APPLICATIONS.***

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3 and 11 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. (U.S. Patent No 6,301,609) in view of Ilsen et al (U.S. Patent No 6,757,898) and further in view of Cooper et al. (U.S. Patent No. 5,757,908)

Referring to claims 1 and 11, Aravamudan et al. teaches a method for registering or inviting registration to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types (Figure 1, 140), selectively interconnected to an IM server by way of a computer network (Figure 1, 122), the method comprising the following steps: receiving a client specific access address of a prospective user on

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the computer network together with a request to register or tentatively register an account for said prospective user (Column 6, Lines 32-45); automatically generating and allocating a unique identifier to the prospective user (Column 6, Lines 50-55); matching said unique identifier to the client specific access address of the prospective user (Column 6, Lines 58-63), wherein if the initial receiving was a direct request to register from the prospective user, registering and account for said prospective user by storing the matched unique identifier and client specific access address with said IM server under the unique identifier with said IM server under the unique identifier (Column 6, Lines 58-63), but does not teach determining whether the initial receiving was associated with a request to register from someone other than the prospective user and in response to said determining step, registering an account for said prospective user; and sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, wherein said notification confirms the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; and in response to said determining step, said notification invites registration of the prospective user. Ilsen et al. teaches determining whether the initial receiving was associated with a request to register from someone other than the prospective user (Column 30, Lines 9-15) and in response to said determining step, registering an account for said prospective user (Column 30, Lines 16-30); and sending notification of said unique identifier to said prospective user at the client specific address of the prospective user (Column 30, Lines 25-26), wherein said notification confirms the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user (Column 30, Lines 22-36); and in response to said determining step, said notification invites registration of the prospective user (Column 30, Lines 22-30). Therefore at the time the invention was made, it would have

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been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al. with the teaching of Ilsen et al. of determining whether the initial receiving was associated with a request to register from someone other than the prospective user and in response to said determining step, registering an account for said prospective user; and sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, wherein said notification confirms the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; and in response to said determining step, said notification invites registration of the prospective user in cases where unique identifiers of user information are not met (Column 30, Lines 22-26).

Aravamudan et al. and Ilsen et al teach the limitations of claims 1 and 11, but do not teach providing tentative usage. Cooper et al. teaches providing tentative usage (Column 2, Lines 31-34). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al. and Ilsen et al. with the teaching of Cooper et al. of providing tentative usage to allow the potential user to review the software and determine whether it suits his or her needs (Column 2, Lines 63-65). An account could be tentative based on a trial period or monthly payment being received.

Referring to claim 3, Aravamudan et al. further teaches wherein said computer network is the internet and/or any direct electronic link (Column 3, Lines 39-40).

4. Claim 2 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Cooper et al. and further in view of Gerace (U.S. Patent No. 5,848,396).

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Referring to claim 2, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claim 2, but do not teach wherein the unique identifier is a UIN. Gerace teaches wherein the unique identifier is a UIN (Column 6, Lines 23-24). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of Gerace wherein the unique identifier is a UIN to distinguish one user from another (Column 6, Lines 35-40).

5. Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Cooper et al. and further in view of Kraft (U.S. Patent No. 6,309,305).

Referring to claim 4, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claim 4 but do not teach wherein the prospective user has an email-based client application for accessing the messaging system. Kraft teaches wherein the prospective user has an email-based client application for accessing the messaging system (Column 5, Lines 13-19). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of Kraft wherein the prospective user has an email-based client application for accessing the messaging system to define a sender (Column 5, Line 18).

6. Claims 5 and 6 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Cooper et al. and further in view of McDowell et al. (U.S. Patent Publication No. 2001/0034224).

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Referring to claim 5, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claim 5 but do not teach wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system. McDowell et al teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of McDowell et al wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system to provide a connection to the internet (0014).

Referring to claim 6, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

7. Claims 7, 9, 10, 13, 17, and 19 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Cooper et al. and further in view of Patil (U.S. Patent No. 6,625,460).

Referring to claims 7, 9, 17 and 19, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claims 7 and 9 including wherein the prospective user sends client specific address to a web page, but do not teach sending information via e-mail. Patil teaches sending information via e-mail (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of Patil of sending information

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via e-mail to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 10, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claim 10 including wherein said client specific address is sourced from a web page, but do not teach sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server. Patil teaches sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of Patil of sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 13, Aravamudan et al. further teaches wherein said computer network is the internet and/or any direct electronic link (Column 3, Lines 39-40).

8. Claim 8 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Cooper et al. and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claim 8, Aravamudan et al., Ilsen et al and Cooper et al. teach the limitations of claim 8, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-

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mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al., Ilsen et al and Cooper et al. with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

9. Claim 12 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al., Cooper et al. and Patil and further in view of Gerace.

Referring to claim 12, Aravamudan et al., Ilsen et al., Cooper et al. and Patil teach the limitations of claim 12, but do not teach wherein the unique identifier is a UIN. Gerace teaches wherein the unique identifier is a UIN (Column 6, Lines 23-24). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al., Ilsen et al., Cooper et al. and Patil with the teaching of Gerace wherein the unique identifier is a UIN to distinguish one user from another (Column 6, Lines 35-40).

10. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al., Cooper et al. and Patil and further in view of Kraft.

Referring to claim 14, Aravamudan et al., Ilsen et al., Cooper et al. and Patil teach the limitations of claim 14, but do not teach wherein the prospective user has an email-based client application for accessing the messaging system. Kraft teaches wherein the prospective user has

an email-based client application for accessing the messaging system (Column 5, Lines 13-19).

Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al., Ilsen et al, Cooper et al. and Patil with the teaching of Kraft wherein the prospective user has an email-based client application for accessing the messaging system to define a sender (Column 5, Line 18).

11. Claims 15 and 16 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al., Cooper et al. and Patil and further in view of McDowell et al.

Referring to claim 15, Aravamudan et al., Ilsen et al., Cooper et al. and Patil teach the limitations of claim 15 but do not teach wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system. McDowell et al teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al., Ilsen et al., Cooper et al. and Patil with the teaching of McDowell et al wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system to provide a connection to the internet (0014).

Referring to claim 16, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

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12. Claims 18 and 20 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al, Ilsen et al., Cooper et al and Patil and further in view of Smith et al.

Referring to claims 18 and 20, Aravamudan et al, Ilsen et al., Cooper et al and Patil teach the limitations of claims 18 and 20, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al, Ilsen et al., Cooper et al. and Patil with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Floyd et al. U.S. Patent No. 6,243,692 discloses secure electronic software packaging using setup-external locking module.

Goldstein U.S. Patent Publication No. 2002/0029173 discloses system and method for providing customers with product samples.

Salas et al. U.S. Patent Publication No. 2002/0087476 discloses method and apparatus for controlling access to a product.


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14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.


Ewart
July 3, 2006


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